

REMARKS

Attached hereto is a request for an extension of time and the appropriate fee.

Applicant wishes to thank Examiner Field for the courtesy and the communications on the status of the present application.

Applicant also wishes to thank Examiner Hong for the courtesy of an interview. During the interview, the issue of the 35 U.S.C. § 112 Paragraph 1 rejection was discussed. More specifically, it was pointed out that the claims rejected were still completely supported and enabled even if "successively" was removed under Paragraph 1 of § 112 and that applicant did not understand the logic behind this rejection.

In light of the extensive prosecution record, applicant, however, will proceed forward to respond in full.

Examiner Hong indicated he would take this point under consideration upon filing of a formal response.

To provide perspective, applicant, in preparing and filing the present application, disclosed four embodiments and suggested various modification or hybrids of the four embodiments in the original patent application. Upon examination of the original application, there was no restriction requirement imposed since the same inventive feature was set forth in each of the embodiments. This included whether the multi-media information device was recording or playing back the multi-media information and equally whether it was recording or playing back information from a CD Rom or reading and playing back information from a data server connected via a network.

The Office Action acknowledges that the term "successively stored" was never at issue nor a basis for a rejection in the prosecution of U.S. Patent No. 5,767,845. Additionally, the

Office Action further acknowledges that it was known by those of ordinary skill in the art that data stored on a hard disk does not necessarily have to be stored “successively”. Accordingly, the subject matter of Claims 10-15, 16-18 and 22-24 should not be at issue.

It is also believed that each of the embodiments is allowable over the prior art since they are directed to both using and formatting page information that permits the creation of display data on a screen image by placing partial images listed, for example, on a partial image list, so that new display data can be created by changing the display state of the corresponding partial image according to display state change commands which can be stored and implemented by an input from an operator.

The Office Action also acknowledged that the original reissue declaration was not defective simply because the reissue declaration also cited additional desired corrections which were acceptable, such as changing “disk” to “recording medium.”

The remaining issue, however, is a claim that the proposed amendments to the Claims 1-9, 19-21 and 25-26 raise enablement requirements under 35 U.S.C. § 112, first paragraph, purportedly because the subject matter is not described in the specification in such a way as to enable one skilled in this art to make or use the invention.

The rationale for this rejection is that with regards to Embodiments 1 and 2, the specification describes an advantage of successive storage such as a page stream and timeline stream in storage areas on the same track of a CD Rom to minimize search time by a pick-up head.

The test of an enablement is set forth in the MPEP § 2164.01 which requires an analysis of whether a particular claim is supported by a disclosure in an application by determining whether that disclosure contains sufficient information regarding the subject matter of the claims

as to enable one skilled in the pertinent art to make and use the claimed invention. As further set forth, the test of enablement is whether one reasonably skilled in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

Factors to consider for undue experimentation are set forth in the MPEP § 2164.01(a). Applying these tests to the present claims, it can be seen that the breadth of the claims is primarily concerned with the relationship of the page information and how it will be processed and displayed. The issue of whether a recording medium has pieces of page information stored in a storage area or successively stored in a storage area is a minor issue. Removing the terminology "successively" is not significant to the breadth of the claims. This is particularly true when claims have already been allowed that are not so limited by the term "successively". The nature of the invention is directed to providing an improvement in creating new display data, and these features are not disclosed within the state of the prior art. In fact, whether information is stored successively or not is certainly not a critical element of the invention. The level of ordinary skill in this art is certainly aware of storing information in different memory devices inclusive of both CD Roms and hard drives. The predictability of the results in this art is also very clear in that information can be stored and used in the present invention whether successively or simply stored in a storage area.

Of importance is the fact that the inventors provide express directions that permits utilizing a hard drive storage device for a video server as an equivalent to a CD Rom. The specification of the present invention provides working examples of both a CD Rom and hard drive storage devices, and also a hybrid of such in the second embodiment where the hard drive is specifically utilized for having the information written into, and then only at the end of the

processing is the information then transmitted for writing on a CD Rom. There is no experimentation needed to make or use the present invention whether with successive storage or simply storing in a storage area. Thus, it would appear that the teachings of *In Re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) as cited and relied upon in MPEP § 2164.01(a) is equally applicable to our present set of circumstances.

Reference can be made specifically to our teachings on Column 18, Lines 42-53, that states, in the First Embodiment, that a CD Rom is not necessary, but that a recording medium such as a storage device for a video server can be utilized. Thus with regards to the Embodiment 1 cited in the Office Action, there is also a specific teaching that successively storing in physically adjacent locations is not necessary and, in fact, Embodiment 1 can be equally implemented with a hard disk drive storage device. There is no question that the present specification discloses at least four different embodiments and fully discloses the manner of making and using each of these embodiments. The present invention is not in an unpredictable area, but is within the electronic arts and utilizes knowledge well known to a person of ordinary skill in this field. This is particularly true since the issue of successive storage does not, in fact, represent a major advancement in the art and was not, in fact, at issue in the prosecution of the claims. Rather, it represented only one type of example.

As acknowledged, the terminology of successively is not an essential element of the present invention nor was it examined as such in the original claims. Rather it is an attribute which can be possibly used to further improve performance when subject to limitations of the read time of a CD Rom player. Such a feature, however, does not limit or address the advantages of the present invention that can be achieved as shown in Figures 8 and 9A through 9F. This is recognized by the claims allowed in the Embodiments 3 and 4.

Applicant does not dispute that optimizing the information from writing on or reading from a CD Rom addresses a head seeking time and may improve performance when a CD Rom unit is detachably attached to the structure that forms the basis of the present invention. Applicant does dispute, however, the requirement the term "successively" has to be read as a limitation since clearly the claim is still enabled and does teach the features of the present invention when the word "successively" is eliminated. Applicant has within the time period of two years sought to remove an unnecessary limitation that relates to the speed of a specific CD reader which is not the present invention, particularly when the present invention teaches as an alternative the use of a hard drive. Why should applicant be restricted in certain claims when it can certainly be understood that the speed of CD readers may improve so that the search time of the head is not necessarily a factor in implementing the present invention, particularly when the present invention teaches as an alternative the use of hard drive storage devices.

This is particularly true when it has been acknowledged by the Patent Office that the other embodiments of this invention are not so limited and that the operation of a hard drive does not require physically successive storage areas. Certainly the ability of a CD reader to approach the pick-up speed on a hard drive disk is a function of cost and not of technology.

Every feature describing an embodiment in a patent specification is not required to be imported into the claim language, and applicant's invention has certainly been recognized as broader than any terminology of "successively" when the issue of recapture was dropped as a rejection.

Applicant would direct the Patent Office to the language set forth in the description of the first embodiment on Column 18, Lines 42-53, as follows:

"Broader interpretation is possible: the recording medium can be a transmission line like a communication line, or a storage device of a video server mentioned later. In the storage area, all information does not have to be stored in the form of digital data. Part of the data, e.g. audio data of the time line stream, can be analog data and can be stored divided. In this case, the multi-media information playback device 200 can be equipped with a storage unit of analog data instead of the audio data storage unit 211." (Emphasis added.)

Thus, the actual specification gives support to a broader interpretation that would not incorporate the limitations of a CD Rom pick-up head specifically when referring to both Embodiments 1 and 2. As can be seen from the above teaching, the storage device of the video server could incorporate a hard disk that has already been acknowledged by the Office Action as storing data in a manner that does not necessarily have to be stored "successively". See page 6, second paragraph of the Office Action.

To provide further perspective to the present claims, reference can also be made to the second embodiment shown, for example, in Figure 13 and implemented in the flow charts of Figures 14 and 15. As can be readily seen in Figure 13, a hard disk 1310 acts as a storage device for enabling the implementation of the generic features of the present invention. The multi-media information recording device 1200 includes the hard disk 1310 and digitized still picture data and motion pictures from, for example, a connected videotape recorder to be both scanned in and captured by a video capture board. As noted on Column 19, Lines 29-33, the operative working second storage unit is implemented by the hard disk 1310. Thus, the important features of the partial image storage unit, the motion picture storage unit, the audio storage unit, the page stream storage unit and the timeline stream storage unit are implemented in the hard disk 1310, which in effect constitutes one form of recording medium.

As can be seen from the flow chart of Figures 14 and 15, the processing and formatting of the data to implement the present invention are performed from step 1403 through step 1428 with all the features of the present invention utilizing the storage capacity of the hard disk in nonsuccessive formats. As can be seen from the decisional box of 1402 in Figure 14, only when there is no content to be described by a page stream is the data removed from the hard disk 1310 and written to the CD Rom; see Column 21, Line 61, through Column 22, Line 5. Thus the present invention, as implemented with a multi-media information playback device, can simply take the same stored information from the hard disk and implement it in a successive manner on a removable CD Rom as simply an improvement in facilitating the limitations of CD Rom readers. It should be noted that the specification immediately sets forth in the next paragraph, Column 22, Lines 12-14, as follows:

"Also, each page stream and time line stream can be stored successively in the storage areas in the same track of the CD Rom 1210."

Webster's II, New Riverside University Dictionary states that the terminology can is used to indicate a possibility or a probability and further is used more often than "may" to express permission. Thus, the statement in our specification on page 22 indicates that such information can be permissively stored successively in the storage areas of the same track on a CD Rom to achieve one attribute of a feature of one embodiment. It is not, however, an essential feature of the invention at issue, and a hard drive can be used as an equivalent. Applicant is not aware of any case law cited in the Office Action that requires an incorporation of all the specification features of a specific species, let alone a permissive feature, no matter how desirable, into a claim limitation.

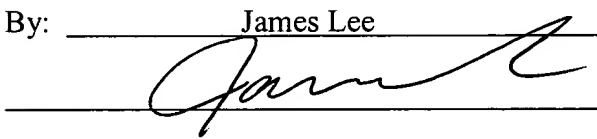
Although applicant was granted individual claims, each with patentably allowable generic elements, these claims did not represent a generic claim to which applicant was entitled that could read on one or more species of the present invention.

Amending Claim 1 to remove the limitation of disk while appropriately setting forth "recording medium" and removing the limitation of "successively" when referring to storage in a storage area is consistent in providing a broader generic claim and in removing an unnecessary limitation even when implemented in a disc storage device.

The Patent Office has not met its burden of showing any experimentation is necessary, let alone "undue experimentation", to justify a 35 U.S.C. § 112 rejection on grounds of lack of enablement.

It is believed that the present reissue claims are allowable, and if the Examiner believes that a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number..

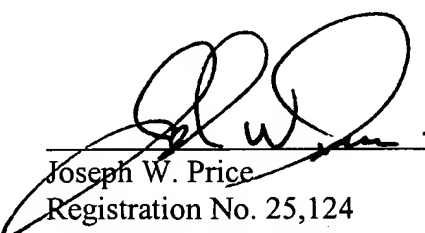
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 14, 2003.

By: James Lee

Signature

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Respectfully submitted,

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